

Application No. 10/802,906  
Amendment dated June 10, 2009  
Reply to Office Action of December 10, 2008

### **REMARKS**

#### **I. 35 U.S.C. § 102(b) Rejections**

According to MPEP § 706.02 Part V, "for anticipation under 35 U.S.C. 102, the [prior art] reference must teach every aspect of the claimed invention either explicitly or impliedly." Independent claims 7 and 47 are directed to an orthopedic implant including a locking element "being moveably attached to said implant prior to the insertion of the bone screws into said bone screw receiving holes." Furthermore, claim 42 is directed to an orthopedic implant including a locking element "being moveably attached to said implant prior to the insertion of said at least two bone screws into said at least two bone screw receiving holes." As discussed below, the references cited by the Examiner under 35 U.S.C. § 102(b), U.S. Patent Nos. 2,825,329 to Caesar ("Caesar") and 4,488,543 to Tomler ("Tomler"), do not disclose these aspects of the claimed invention as recited in independent claims 1, 42, and 47. Accordingly, Applicant respectfully submits that the Examiner's rejections of Independent claims 7, 42, and 47 under 35 U.S.C. § 102(b) are respectfully traversed.

In the "Response to Arguments" section of the Office Action, the Examiner indicates that "it was felt that 'moveably attached to said implant prior to the insertion of the bone screws' was a functional rather than structural limitation." (Office Action at page 8, lines 16-18.) In response, Applicant submits that the recitations of independent claims 7, 42, and 47 included above articulate the structural relationship between the locking element and the implant recited therein. More broadly, the recitations of independent claims 7, 42, and 47 included above define the structural attributes of the claimed invention. As such, Applicant submits that these recitations of independent claims 7, 42, and 47 should be accorded their proper patentable weight.

Furthermore, in the "Response to Arguments" section of the Office Action, the Examiner indicates that "[t]he elements being interpreted as locking elements in both references are fully capable of being attached before any insertion of the bone screws." (Office Action at page 8, lines 18-20.) As discussed below, neither of the references cited by the Examiner, Caesar or Tomler, disclose (in the Examiner's words) a "locking

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element" that is "capable of being attached before insertion of bone screws." More specifically, contrary to the Examiner's contentions, neither Caesar nor Tornier disclose a locking element for locking at least two bone screws inserted in at least two bone screw receiving holes, where the locking element is "moveably attached to said implant prior to the insertion of the bone screws into said bone screw receiving holes" as recited in independent claims 7 and 47, or disclose a locking element for locking at least two bone screws inserted in at least two bone screw receiving holes, where the locking element is "moveably attached to said implant prior to the insertion of said at least two bone screws into said at least two bone screw receiving holes" as recited in independent claim 42.

A. Rejection under 35 U.S.C. § 102(b) based on Caesar

In the Office Action, the Examiner rejected claims 7-10, 13-16, 18-29, 35, 38-42, and 44-51 (including independent claims 7, 42, and 47) under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,825,329 to Caesar. Contrary to the Examiner's contentions, however, Caesar does not disclose every aspect of Independent claims 1, 42, and 47.

In rejecting independent claims 1, 42, and 47, the Examiner contends that Caesar discloses "a locking element (140)" that is "capable of locking the screws (158)... through the use as shown in Figures 1-3." (Office Action at page 2, lines 19-20.) Regarding Figs. 1-3 of Caesar, Applicant submits that a second plate 150 and a plate 140 thereof are attached to one another only after bone screws 158 are inserted into openings 156 of the second plate 150 and into openings 146 of the plate 140. As such, the second plate 150 is attached to the plate 140 as a result of, not prior to, the insertion of the bone screws 158 into the openings 156 of the second plate 150 and the openings 146 of the plate 140. Therefore, Applicant submits that Figs. 1-3 of Caesar do not disclose a locking element "being moveably attached to said implant prior to the insertion of the bone screws into said bone screw receiving holes," as recited in independent claims 7 and 47. Furthermore, Applicant submits that Figs. 1-3 of Caesar do not disclose a locking element "being moveably attached to said implant prior to the

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insertion of said at least two bone screws into said at least two bone screw receiving holes," as recited in independent claim 42.

Additionally, in rejecting independent claims 1, 42, and 47, the Examiner contends that Caesar discloses "a locking element (140)" that "can also merely cover the top of plate (150) and be rotated, slid, etc[.] into and out of alignment for allowing the screws through holes (156)." (Office Action at page 2, lines 20-21.) However, as discussed above, the second plate 150 is attached to the plate 140 as a result of, not prior to, the insertion of the bone screws 158 into the openings 156 of the second plate 150 and the openings 146 of the plate 140. Furthermore, even if, as the Examiner contends, the plate 140 was used to cover the top second plate 150, Applicant submits the bone screws 158 would still be used to facilitate attachment. Thus, the bone screws 158 would be inserted into the openings 156 of the second plate 150 and the openings 146 of the plate 140 before attachment of the second plate 150 and the plate 140 with one another. Therefore, Applicant again submits that Caesar does not disclose a locking element "being moveably attached to said implant prior to the insertion of the bone screws into said bone screw receiving holes," as recited in independent claims 7 and 47. Furthermore, Applicant again submits that Caesar does not disclose a locking element "being moveably attached to said implant prior to the insertion of said at least two bone screws into said at least two bone screw receiving holes," as recited in independent claim 42.

Accordingly, Caesar does not disclose every aspect of the claimed invention recited in independent claims 7, 42, and 47, and thus, Applicant submits that the Examiner's rejection thereof under 35 U.S.C. § 102(b) cannot be maintained. As such, the Examiner's rejection of claims 7-10, 13-16, 18-29, 35, 38-42, and 44-51 under 35 U.S.C. § 102(b) based on Caesar has been overcome.

**B. Rejection under 35 U.S.C. § 102(b) based on Tomier**

The Examiner rejected claims 7-29, 35, and 38-41 (including independent claim 7) under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,488,543 to Tomier. Contrary to the Examiner's contentions, however, Tomier does not disclose

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every aspect of independent claims 1, 42, and 47.

As shown in Figs. 2 and 3 of Tornier, a disc 11 is attached to a plate 2 using a screw 9. The disc 11 is used to cover the heads of screws 3. According to Tornier, the disc 11 "has centrally between the three holes a diameter which partially covers each of heads 3a of screws 3 to assure their being held in corresponding holes 6." (Tornier, col. 2, lines 37-40.) Because the disc 11 covers the heads 3a of the screws 3, Applicant submits that the disc 11 of Tornier is attached to the plate 2 after the insertion of the bone screws 3 into the bone screw receiving holes 6.

In rejecting independent claim 7, the Examiner contends that either: (1) the screw 9 and the disc 11 are "a locking element" (Office Action at page 3, line 9), or (2) the disc 11 is "a locking element" (Office Action at page 3, lines 13 and 14). However, in either instance, the disc 11 of Tornier is attached to the plate 2 after the insertion of the screws 3 into their corresponding holes 6. As discussed above, independent claim 7 recites a locking element "being moveably attached to said implant prior to the insertion of the bone screws into said bone screw receiving holes." Thus, unlike independent claim 7, Tornier, at the very least, does not disclose a locking element moveably attached to an implant prior to the insertion of the bone screws into the bone screw receiving holes.

Accordingly, Tornier does not disclose every aspect of the claimed invention recited in independent claim 7, and thus, Applicant submits that the Examiner's rejection thereof under 35 U.S.C. § 102(b) cannot be maintained. As such, the Examiner's rejection of claims 7-29, 35, and 38-41 under 35 U.S.C. § 102(b) based on Tornier has been overcome.

## II. 35 U.S.C. § 103(a) Rejections

Additionally, the Examiner rejected claims 30-34, 36, and 37 under 35 U.S.C. § 103(a) as being unpatentable over Caesar; and rejected claims 30-34, 36, and 37 under 35 U.S.C. § 103(a) as being unpatentable of Tornier. Applicant submits that the rejections of claims 30-34, 36, and 37 are rendered moot at least because these claims depend from an allowable independent claim, or claims dependent therefrom.



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### III. Double Patenting Rejections

The Examiner rejected claims 7-42 and 44-51 under the judicially created doctrine of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-173 of U.S. Patent No. 6,193,721 ("721 patent"), claims 1-39 of U.S. Patent No. 6,936,051 ("051 patent"), and claims 1-117 of U.S. Patent No. 6,398,783 ("783 patent") in view of U.S. Patent No. 5,468,242 ("242 patent"). The Examiner also provisionally rejected claims 7-42 and 44-51 under the judicially created doctrine of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-72 of copending Application No. 10/926,734 ("734 application") and claims 1-62 of copending application No. 11/128,556 ("556 application") in view of the '242 patent.

Applicant respectfully disagrees with the Examiner's double patenting rejections based on the '721, the '051, and the '783 patents at least for the reasons discussed on pages 11-14 of the Amendment dated November 30, 2007. However, in the interest of expediting the prosecution of this application, Applicant acknowledges the Examiner's obviousness-type double patenting rejections and reserves the right to address the double patenting rejections upon allowance of the claims in one of the present application, the '734 application, and the '556 application to determine if a Terminal Disclaimer is required at that time.

### IV. Conclusion

In conclusion, Applicant submits that independent claims 7, 42, and 47 are patentable and that dependent claims 8-41, 44-46, and 48-51 dependent from independent claim 7, 42, or 47, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim. Therefore, in view of the foregoing remarks, it is respectfully submitted that the claims are patentable. Accordingly, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any


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fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

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Dated: June 10, 2009

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